

REMARKS

Assignee and the undersigned attorney thank Examiner Chang for his review of this patent application. In the above amendment, claim 8 is amended. Claims 9-19 have been withdrawn from further consideration under 37 C.F.R. § 1.142(b) as being drawn to a non-elected invention. Assignee respectfully requests reconsideration of pending claims 1-8.

Restriction Requirement

Assignee affirms the election of Group I, claims 1-8.

Drawings

The Examiner objected to the drawings submitted with this application because they are informal. As an Appendix hereto, Assignee submits two sheets of formal drawings.

Claim Objections

The Examiner objected to claim 8 because of an informality. Claim 8 is amended above to correct the informality. Thus, the objection to claim 8 should be withdrawn.

Claim Rejections

The Action rejected claims 1-6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,806,404 to *Cascino* ("*Cascino '404*") in view of U.S. Patent No. 5,328,937 to *Cascino* ("*Cascino '937*"). The Action rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Cascino '404* in view of *Cascino '937*, or further in view of U.S. Patent No. 3,616,029 to *Lerman* ("*Lerman*").

Claim 1 recites:

A spacer suitable for use in separating smooth surfaces of adjacent pieces of fragile material, comprising:

a first foam layer with a tendency to cling to smooth surfaces;
and

bonded to the first foam layer to form a single structure without the use of adhesives, laminations, or other bonding agents, a second foam layer having a higher density and a lower tendency to cling to smooth surfaces than the first foam layer.
(emphasis added)

Assignee respectfully submits that *Cascino '404* and *Cascino '937*, alone or in combination, do not teach or suggest first and second foam layers bonded to form a single structure without the use of adhesives, laminations, or other bonding agents, as recited in claim 1.

Cascino '404 teaches a spacer member 12 with a first base layer 14 and a second tack layer 16. In the only example spacer described in *Cascino '404*, an acrylic adhesive is applied to the base layer (closed cell polyethylene) and the tack layer (PVC-plasticizer foam) is then laminated to the base layer by passing both layers through nip rollers. See col. 2, lines 28-32. *Cascino '937* simply teaches that one may substitute a foamable PVC resin for the base layer (or cork layer) in a spacer such as the one described in *Cascino '404*. *Cascino '937* teaches that this cork-replacing foam layer is laminated to the tack layer or otherwise adhered to a surface. See Abstract.

The background of the present application describes conventional spacers, such as those taught by *Cascino '404* and *Cascino '937*, which require an additional adhesive layer

between the base layer and the tack layer of the spacer. In contrast to these spacers, the present application teaches one or more embodiments of a spacer in which the first and second foam layers are bonded together to form a single structure without the use of any adhesive. See paragraphs 7, 8, 19, and 20 of US2003/0035942 (the published version of the present application). It is clear that *Cascino '404* and *Cascino '937* do not teach or suggest a spacer with first and second foam layers bonded to form a single structure without the use of adhesives, laminations, or other bonding agents, as recited in claim 1.

For the above reasons, *Cascino '404* and *Cascino '937*, alone or in combination, do not teach or suggest each and every limitation of claim 1. Thus, the § 103(a) rejection of claim 1 should be withdrawn, and claim 1 should be allowed. Inasmuch as claims 2-8 depend from and thereby include the limitations of claim 1, claims 2-8 should also be allowed for at least such dependencies. Claim 7 should be allowed for the following additional reason.

Embossing for improved cushioning, which the Examiner states is well known in the art and taught by *Lerman*, is taught away from by *Cascino '404*. First base layer 14 of *Cascino '404* must be formed of a semi-rigid material sufficient to provide a backing for tack layer 16. See col. 1, lines 66-68. Embossing a surface of base layer 14 may, in fact, make the spacer too compressible and unable to withstand the weight of numerous sheets of glass, and thus additional cushioning may not be desirable. As discussed in the present application,

USSN: 10/010,054
Amendment and Response to Office Action and
Petition for One-Month Time Extension

the exposed surface of the higher-density, second foam layer is embossed for the purpose of reducing the surface area that contacts the adjacent glass to reduce the attraction of this second foam layer to the glass. *See* paragraph 15 of US2003/0035942. Assignee submits that it would not have been obvious to one skilled in the art to emboss the exposed surface of the second (higher density) foam layer to provide an improved cushioning property as suggested by the Examiner.

The foregoing is submitted as a full and complete response to the Office Action mailed July 2, 2004. Assignee submits that claims 1-8 are allowable for at least the reasons set forth above, and allowance of these claims is respectfully requested. The preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

Respectfully submitted,



Geoffrey K. Gavin
Registration No. 47,591

KILPATRICK STOCKTON LLP
Suite 2800
1100 Peachtree Street
Atlanta, Georgia 30309-4530
(404) 815-6046
Attorney Docket No.: I4060/249318 (IRC296)